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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/712,951	11/13/2003	Larry J. Pacey	WMS-029	9624
30223	7590	02/05/2008	EXAMINER	
NIXON PEABODY LLP 161 N. CLARK STREET 48TH FLOOR CHICAGO, IL 60601-3213				THOMAS, ERIC M
ART UNIT		PAPER NUMBER		
3714				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/712,951	PACEY, LARRY J.	
	Examiner	Art Unit	
	Eric M. Thomas	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 13 November 2007.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-20 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

<ol style="list-style-type: none"> <li>1)<input checked="" type="checkbox"/> Notice of References Cited (PTO-892)</li> <li>2)<input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)</li> <li>3)<input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.</li> </ol>	<ol style="list-style-type: none"> <li>4)<input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.</li> <li>5)<input type="checkbox"/> Notice of Informal Patent Application</li> <li>6)<input type="checkbox"/> Other: _____.</li> </ol>
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**DETAILED ACTION**

***Response to Amendment***

This is in response to the amendments filed on 11/13/07, claims 1 and 4 - 19 have been amended, and claim has been added. Claims 1 - 20 are now pending in the current application.

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1 – 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marks (U.S. 2003/0157981) in view of Luciano (U.S. 6,050,895).**

2. Regarding claims 1 and 6, Marks discloses a method of conducting a wagering game on a gaming machine, comprising: receiving a wager from a player to initiate play of the wagering game (para. 0018); randomly selecting a plurality of symbols to form a first array (para. 0018); displaying the first array (para. 0018); identifying winning symbols in the first array that form any first winning combination (para. 0019); awarding the player for the first winning combination in the first array (para. 0019); replacing one or more of the winning symbols in the first array that form the first winning combination with a randomly determined replacement symbol to form a second array (para. 0019); displaying the second array (para. 0019); identifying winning symbols in the second

array that form any second winning combination (para. 0019); and awarding the player for the second winning combination in the second array (para. 0019).

Regarding claim 2, Marks discloses wherein less than all of the winning symbols that form the first winning combination are replaced (para. 0089).

Regarding claim 3, Marks discloses wherein a wild symbol is one of the winning symbols forming the first winning combination (para. 0085-86) and is not replaced (para. 0089).

Regarding claims 4, 5, 13, and 16, Marks discloses a gaming machine and method of conducting a wagering that includes a basic wagering game and a bonus wagering game that has a pay structure that is paid in accordance with a pay table, (col. 2, lines 45 - 50, col. 4, lines 14 – 17, and col. 11, lines 10 – 13), but is silent on the issue of containing a second pay table. In a related art, however, Luciano provides a gaming device that teaches the use of a second pay table (col. 7, lines 20 - 25). Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Luciano into the art disclosed by Marks in order to provide different odds of winning rewards or prizes.

Regarding claims 7 and 8, Marks discloses a method of conducting a wagering game on a gaming machine, comprising: receiving a wager from a player to initiate play of the wagering game (para. 0018); randomly selecting a plurality of symbols to form a first array (para. 0018); displaying the first array (para. 0018); identifying any first winning pay line (para. 0004 and 0019); awarding the player for the first winning pay line in the first array (para. 0004 and 0019); randomly determining a replacement symbol for

each of the symbols on the first winning pay line in the first array (para. 0052); replacing one or more of the symbols on the first winning pay line in the first array with the randomly determined replacement symbols to form a second array (para. 0077); displaying the second array (para. 0019); and awarding the player for any second winning pay line in the second array (para. 0019), but is silent on the issue of containing a second pay table. In a related art, however, Luciano provides a gaming device that teaches the use of a second pay table that could be used as the pay table for the bonus game (col. 7, lines 20 - 25). Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Luciano into the art disclosed by Marks in order to provide different odds of winning rewards or prizes.

Regarding claim 9, Marks discloses a method of conducting a wagering game that discloses a wild symbol as a winning symbol on at least one of any winning combination and second winning combination along one or more pay lines (col. 3, lines 9 - 14).

Regarding claims 10, 17, and 18, Marks discloses a method of conducting a wagering game on a gaming machine, comprising: receiving a wager from a player to initiate play of the wagering game (para. 0018); randomly selecting a plurality of symbols to form a first array (para. 0018); displaying the first array (para. 0018); identifying a first winning symbol in the first array that creates any first winning outcome (para. 0019); awarding the player for the first winning outcome (para. 0019); replacing the first winning symbol with a randomly determined first replacement symbol to form a second array (para. 0019); displaying the second array (para. 0019); identifying a

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second winning symbol in the second array that creates any second winning outcome (para. 0019); and awarding the player for the second winning outcome (para. 0019); and a data input apparatus that is used to receive the player selections of at least one of the plurality of pay lines (col. 4, lines 43 - 45).

Regarding claim 11, Marks discloses further including: replacing the second winning symbol with a randomly determined second replacement symbol to form a third array (para. 0019); displaying the third array (para. 0019); identifying a third winning symbol in the third array that forms any third winning outcome (para. 0019); and awarding the player for the third winning outcome (para. 0019).

Regarding claims 12, 15, and 19, Marks discloses a gaming machine for conducting a wagering game on a gaming machine, comprising: receiving a wager from a player to initiate play of the wagering game (para. 0018); randomly selecting a plurality of symbols to form a first array (para. 0018); displaying the first array (para. 0018); identifying at least one start-bonus symbol in the first array (para. 0005); replacing each start-bonus symbol with a randomly determined replacement symbol to form a second array (para. 0019); displaying the second array (para. 0019); identifying any winning bonus game outcome in the second array (para. 0019); and awarding the player for the winning bonus game outcome (para. 0019), but is silent on the issue of containing a second pay table. In a related art, however, Luciano provides a gaming device that teaches the use of a second pay table that could be used as the pay table for the bonus game (col. 7, lines 20 - 25). Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Luciano into

the art disclosed by Marks in order to provide different odds of winning rewards or prizes.

Regarding claim 14, Marks discloses a gaming machine for conducting a wagering game on a gaming machine, comprising: receiving a wager from a player to initiate play of the wagering game (para. 0018); randomly selecting a plurality of symbols to form a first array (para. 0018); displaying the first array (para. 0018); identifying winning symbols in the first array that form a scatter pay (para. 0019 and 0087-88); awarding the player for the scatter pay in the first array (para. 0088); replacing each of the winning symbols with a randomly determined replacement symbol to form a second array (para. 0019); displaying the second array (para. 0019); and awarding the player for a winning outcome in the second array (para. 0019).

Regarding claim 20, Marks discloses a computer readable storage medium that is capable of being encoded with instructions for performing the tasks of the gaming system (col. 5, lines 50 – 55).

#### ***Response to Arguments***

3. Applicant's arguments filed 11/13/07 have been fully considered but they are not persuasive. Regarding claims 1 – 3, 6, 9 - 11, and 14, applicants' states that "Marks fails to disclose any pre-defined pay lines that are associated with Marks wagering game." The examiner respectfully disagrees. In col. 1, lines 50 – 55, Marks states that "for each winning outcome, which may be predetermined symbol combinations along any enabled pay line for the machine or a set of predetermined scattered symbols, the

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processor issues an award to the player." The examiner interprets the enabled pay line as being selected by the player of the gaming machine, thus making it a pre-defined player-selectable pay line. For reasons stated above, the arguments are deemed not to be persuasive.

4. Applicant's arguments with respect to claims 4, 5, 7, 8, 12, 13, 15, 16, and 19 have been considered but are moot in view of the new ground(s) of rejection.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric M. Thomas whose telephone number is (571) 272-1699. The examiner can normally be reached on 7a.m. - 3p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on (571) 272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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